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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/712,227

11/15/2000

Noriko Kawai

1035-291

8669

23117

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12/15/2004

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EXAMINER

NORRIS, JEREMY C

ART UNIT

PAPER NUMBER

2841

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/712,227

Applicant(s)

KAWAI ET AL.

Examiner

Jeremy C. Norris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-7 and 12-39 is/are pending in the application.
- 4a) Of the above claim(s) 12-17, 28, 34 and 35 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-7, 18-27, 29-33 and 36-39 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Claim 4 is generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claim 7 is no longer withdrawn from consideration since this claim includes each of the limitations of an allowed generic claim. However, claims 12-17, 28, 34, and 35 remain withdrawn from consideration since these claims do not depend upon or otherwise include all the limitations of an allowed generic claim as required by 37 CFR 1.141.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

### ***Allowable Subject Matter***

Claims 4-7, 18-27, 29-33, and 36-39 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: Examiner finds Applicants' arguments submitted 07 October 2004 persuasive. Specifically, Examiner is persuaded by Applicants' assertion that "If the adhesive disclosed in Inaba was used in the structure of Armezzani, a solvent of the adhesive

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would dissolve the dry film (solder mask 5, 6), causing it to mix with the adhesive. As a result, the function of the dry film would be lost. Accordingly, one of ordinary skill in the art would never have made such a combination, because to do so would destroy the functionality of the resulting device". Examiner agrees that eliminating the dry film via dissolving in the adhesive solvent would ruin the solder mask essential to the invention of Armezzani. Thus one of ordinary skill in the art would not be motivated to modify the invention of Armezzani in such a manner. Thus it is concluded that Applicants' instantly claimed invention is neither disclosed nor suggested by the prior art.

### ***Conclusion***

This application is in condition for allowance except for the following formal matters:

Claims 12-17, 28, 34, and 35, non-elected with traverse remain withdrawn from consideration.

A shortened statutory period for reply to this action is set to expire **ONE MONTH** from the mailing date of this letter.

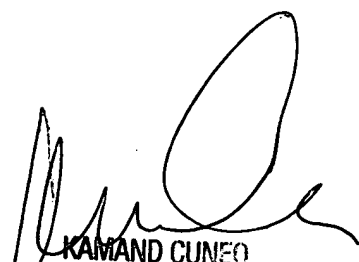
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy C. Norris whose telephone number is 571-272-1932. The examiner can normally be reached on Monday - Friday, 9:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on 571-272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JCSN



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